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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,945	06/22/2001	Sanac Okuyama	SON - 2132	6219

23353 7590 04/03/2007	EXAMINER	
RADER FISHMAN & GRAUER PLLC	MILIA, MARK R	
LION BUILDING		
1233 20TH STREET N.W., SUITE 501	ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036	2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/885,945	OKUYAMA ET AL.
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 January 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 1/3/07 and has been entered and made

of record. Further, the after-final amendment that was received on 3/31/06 has also

been entered and made of record. The contents of which are substantially the same as

that of the current amendment received on 1/3/07. Currently, claims 1-7 are pending.

Claim Rejections - 35 USC § 112

2.   The entry of the amendment received on 3/31/06 has overcome the rejection of

claims 1, 6, and 7, as cited in the previous Office Action, and therefore the rejection has

been withdrawn.

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

        Claim 4 recites the limitation "said character special feature information" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claim 7, while defining a recording medium, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to recite, "A computer-readable medium encoded with computer-readable instructions implemented by a computer..." in order to make the claim statutory.

Response to Arguments

6.   Applicant's arguments with respect to claims 1, 6, and 7 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner would like to respond to a few of the remarks presented by the applicant to further clarify the record. The applicant asserts, on page 9 of the remarks, that Silverbrook (US 6835135) does not teach that the standard DVD game discs **10** store character data on a character or that the memory **52** stores data on a character. The examiner respectfully disagrees as character data must be stored on either the DVD game discs **10** or the memory **52**, otherwise no character would exist within the game and the game which the DVD game disc contains would be utterly useless. It is inherent that a game disc store information essential and relevant to the performance and execution of the game. Further, Silverbrook states that brag cards can be printed with <u>chosen characters</u> (see column 4 lines 1-2), which further evidences the fact that character data is present. It is well known in the art for DVD game discs to contain character data of a character that exists in the game. Even further, Kurosawa (US 6807521) states that a game disc stores character information that is then transferred to a storage area located with the gaming system. Therefore, Silverbrook does in fact teach storing character data, said character data being data representing a character appearing in a game. The applicant also asserts that Silverbrook does not teach character extraction means for extracting said character data from said character data storage means. The examiner respectfully disagrees as Silverbrook does in fact disclose such a feature. Particularly, Silverbrook

states that the DVD game disc is a storage medium for storing the video game and all

associated information regarding the video game. The user can print out brag cards a

certain points in the game and personalized the cards by choosing a character, among

other things. As such, it can be seen from the reference that the character is stored on

the DVD game disc and is extracted by processor 51 to print the brag card when the

user decides to do so. Support for the above can be found in column 2 lines 58-60,

column 3 line 61-column 4 line 7, column 4 lines 11-18, and column 7 lines 15-24). The

applicant also asserts that Silverbrook does not teach inputting card layout information

specifying a card layout. The examiner respectfully disagrees as Silverbrook discloses,

if not, at the very least suggests such a feature. Particularly, Silverbrook states that a

user can personalize the brag card with the game players name, chosen character,

accumulated wealth or objects, etc. and also map a photographic likeness on to 3D

characters. This is seen to be card layout information as each option chosen by the

user to add to the brag card would have a designated location to print on the card and

by inputting which options to add to the brag card to print the user is by default also

inputting card layout information. The applicant lastly asserts that Silverbrook does not

teach generating card display image information, said card display image information

indicating positioning of said character within a card display image. Although

Silverbrook does not expressly disclose such a feature, Silverbrook does however elude

to, or at the very least would be obvious to one of ordinary skill in the art at the time the

invention was made to stipulate or extract the idea of, displaying the card layout

information to allow positioning of the character and other chosen information the will

make up the brag card (see column 3 line 61-column 4 line 18, column 5 line 66-column

6 lines 10, and column 7 lines 15-24). Displaying layout information and determining

positioning are well known and commonly used techniques in the art to setup the

printing of data and are not seen to render the claim unobvious over the prior art.

Claim Rejections - 35 USC § 103

7.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Silverbrook (US 6835135) in view of U.S. Patent No. 6807521 to Kurosawa et al. and

U.S. Patent No. 6200216 to Peppel.

Regarding claim 1, Silverbrook discloses a card making device for making

character cards wherein said card making device is comprised of the following means:

character data storage means for storing data character data, said character data

representing a character (see column 2 lines 58-60 and column 4 lines 13-18, reference

states that character data is stored on DVD game discs, CD-ROMs, or other

conventional memory cartridges, also the print module contains a memory for video

game functions), character data extraction means for extracting said character data

from said character data storage means (see column 3 line 61-column 4 line 7),

character layout information input means for inputting card layout information, said card

layout information specifying the card layout for said character shown in said character

data extracted by said character data extraction means (see column 4 lines 1-7), card

display image information generation means for generating card display image

information (see Fig. 11 (50), column 2 lines 53-55, reference shows a video out source

for displaying images, and column 3 line 61-column 4 line 7), and card display image

information output means for outputting card display image information generated by

the card display image information generation means to a printer (see Figs. 1 and 11,

column 2 lines 35-40, column 3 lines 38-42, and column 3 line 61-column 4 line 7).

Silverbrook does not disclose expressly wherein the character data storage

means is located within (as part of) the card making device and wherein, said card

display image information indicating positioning within a card display image of said

character shown in said character data extracted by said character data extraction

means, said positioning being in accordance with said layout information input by said

character layout information input means.

Kurosawa discloses wherein the character data storage means is located within

the card making device (game console) (see Figs. 1 and 2, column 3 lines 55-61,

column 3 line 66-column 4 line 19, column 4 lines 33-36, and column 4 line 46-column 5

line 45).

Peppel discloses creating an electronic trading card that can incorporate

characters, text, and the like, that can be printed. The creation of the electronic trading

card is performed by organizing (indicating positioning) the contents, such as a

character and text, and previewing the electronic trading card to determine user

satisfaction (see column 8 line 58-column 9 line 19, column 9 lines 50-61, and column 10 lines 5-45).

Regarding claims 6 and 7, Silverbrook discloses a card making method and recording medium stored with a program implemented by computer, comprising: storing character data, said character data being data representing a character, character data storage means storing said character data (see column 2 lines 58-60 and column 4 lines 13-18), extracting said character data from said character data storage means (see column 3 line 61-column 4 line 7), inputting card layout information specifying the card layout for said character shown in said extracted character data (see column 4 lines 1-7), generating card display image information showing the card display image (see Fig. 11 (50), column 2 lines 53-55, and column 3 line 61-column 4 line 7), and outputting said generated card display image information to a printer (see Figs. 1 and 11, column 2 lines 35-40, column 3 lines 38-42, and column 3 line 61-column 4 line 7).

Silverbrook does not disclose expressly wherein the character data storage means is located within (as part of) the card making device and displaying image information showing the card display image placed with said character shown in said extracted character data, according to said input card layout information.

Kurosawa discloses wherein the character data storage means is located within the card making device (game console) (see Figs. 1 and 2, column 3 lines 55-61, column 3 line 66-column 4 line 19, column 4 lines 33-36, and column 4 line 46-column 5 line 45).

Peppel discloses creating an electronic trading card that can incorporate characters, text, and the like, that can be printed. The creation of the electronic trading card is performed by organizing (indicating positioning) the contents, such as a character and text, and previewing the electronic trading card to determine user satisfaction (see column 8 line 58-column 9 line 19, column 9 lines 50-61, and column 10 lines 5-45).

Silverbrook, Kurosawa, & Peppel are combinable because they are from the same field of endeavor, electronic gaming.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the character data storage area located within the game console, as described by Kurosawa, and the positioning and displaying of layout and character information, as described by Peppel, with the system of Silverbrook.

The suggestion/motivation for doing so would have been to provide storing and updating of character data as a game progresses to enhance the interest of the game (see column 1 line 34-column 2 line 11) and provide greater user personalization of a brag card by allowing a user to layout the brag card in a manner that is satisfactory to him/her.

Therefore, it would have been obvious to combine Kurosawa and Peppel with Silverbrook to obtain the invention as specified in claims 1, 6, and 7.

Regarding claim 2, Silverbrook further discloses wherein said character data extraction means extracts said character data from said character data storage means when specified conditions in a game are fulfilled (see column 3 lines 61-67).

Regarding claim 3, Silverbrook further discloses wherein said device further comprises a character selection means for selecting said character, and said character data of said character selected by said character selection means is extracted by said character data extraction means (see column 3 line 61-column 4 line 7).

Regarding claim 4, Silverbrook further discloses wherein said character data includes said character special feature information, said character special feature information showing image information for said character and special features of said character, said character special feature information having a character name for said character or a parameter showing a strength of said character (see column 4 lines 1-7, reference state that a brag card can be personalized with the game players name, chosen character, accumulated wealth or objects, etc., which suggests any attribute of the chosen character or pertinent element of the game can be chosen for the card, of which a character name or strength would be a part of).

Regarding claim 5, Silverbrook further discloses wherein said character layout information is information specifying card layout information items showing features of said character shown in said character special feature information and in the card layout of the image shown in image information on said character (see column 3 line 61-column 4 line 7).
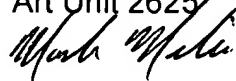
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
Examiner
Art Unit 2625

MRM

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SUPERVISORY PATENT EXAMINER